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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,540	02/10/2004	Shinsuke Okada	P24587	1084
7055	7590	08/03/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/774,540	Applicant(s) OKADA ET AL.	
	Examiner Matthew J. Kasztejna	Art Unit 3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 is/are allowed.
- 6) ☒ Claim(s) 2-7, 15-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice of Amendment*

In response to the amendment filed on July 5, 2006, the finality of the office action mailed April 4, 2006 is *withdrawn*. The rejection of claims 5-6 under 35 USC 112 2<sup>nd</sup> paragraph is *withdrawn*. Claims 8-14 are now allowable over the prior art of record. The following grounds of rejection are made final as the rejections of claims 2-7, 15-18 and 21-23 are merely reiterated and no new prior art or rejections have been made:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-7, 15-18 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,643,653 to Takahashi et al.

**In regards to claim 2**, Takahashi et al. disclose an endoscope comprising: an inserting tube 5 to be inserted into a human body; a first optical system 6 fixed in a tip end of the inserting tube for observing in vivo tissues within a human body at a first magnification; and a second optical system 15 fixed in the tip end of the inserting tube for observing the in vivo tissues at a second magnification that is higher than the first magnification (see Col. 4, Lines 11-15), wherein a portion of the second optical system is within the field of view of the first optical system, and wherein a position of the first

Art Unit: 3739

optical system s fixed in relation to a position of the second optical system within a single inserting tube (see Col. 4, Lines 16-55 and Figs. 1, 3 and 6).

**In regards to claim 3**, Takahashi et al. disclose an endoscope, comprising a tip body 26 mounted on a distal end of the inserting tube, the tip body holding the first optical system and the second optical system (see Fig. 1 and 3).

**In regards to claim 4**, Takahashi et al. disclose an endoscope comprising: an inserting tube 5 to be inserted into a human body; a first optical system 6 secured in a tip end of the inserting tube for observing in vivo tissues within a human body at a first magnification; and a second optical system 15 secured in the tip end of the inserting tube for observing the in vivo tissues at a second magnification that is higher than the first magnification (see Col. 4, Lines 11-15), wherein the first optical system and the second optical system are provided on an end surface of the tip body 26 mounted on a distal end of the inserting tube (see Fig. 3), the second optical system being arranged such that at least a front end portion thereof is protruded with respect to the first optical system, and wherein a position of the first optical system s fixed in relation to a position of the second optical system within a single inserting tube (see Col. 4, Lines 16-55 and Figs. 1 and 6).

**In regards to claims 5-6**, Takahashi et al. disclose an endoscope, wherein the first optical system is arranged such that a front end portion thereof is substantially flush with respect to the end surface of the tip body and wherein an optical axis of the first optical system and an optical axis of the second optical system are substantially parallel with each other (see Fig. 3).

**In regards to claim 7**, Takahashi et al. disclose an endoscope, wherein the second optical system is arranged not to interfere with a central area of the field of view of the first optical system (see Fig 1).

**In regards to claim 15**, Takahashi et al. disclose an endoscope, wherein the tip body is formed with an outlet of a forceps channel for introducing a forceps into the human body (see Fig. 18).

**In regards to claims 16 and 21**, Takahashi et al. disclose an endoscope, wherein the second optical system is inherently capable of being a confocal optical system (see Col. 1, Lines 40-75).

**In regards to claims 17 and 22**, Takahashi et al. disclose an endoscope, further comprising: an imaging device provided in the tip end of the inserting tube, and wherein the first optical system forms an image of a target on the imaging device (see Col. 3, Lines 10-50).

**In regards to claims 18 and 23**, Takahashi et al. disclose an endoscope, further comprising an optical fiber that transmits light returned from the in vivo tissues, only the light from a level of a focal plane of the second optical system being transmitted through the optical fiber (see Col. 3, Lines 27-35).

***Allowable Subject Matter***

Claims 8-14 allowed.

***Response to Arguments***

Applicant's arguments filed July 5, 2006 have been fully considered but they are not persuasive.

Art Unit: 3739

Applicant states that there are two separate inserting tubes for the first and second optical systems of Takahashi et al. However, as seen in Figure 1 of Takahashi et al., both the first 6 and second 15 optical systems fixed within tubes 4 and 14, respectively, are fixed in the tip end of inserting tube 5. Thus as broadly as claimed, the optical systems are fixed within a single inserting tube.

Applicant states that Takahashi et al. fails to disclose an endoscope wherein a position of the first optical system is not fixed in relation to a position of the second optical system within a single inserting tube. The word "fixed" is defined as: to place securely: to make stable or firm (see <http://dictionary.reference.com/browse/fixed>). Thus as broadly as claimed, the optical systems of Takahashi et al. meet the limitations of claim 2 as the optical systems are placed securely within the tube during operation to enable the user to clearly visualize the desired target site.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3739

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

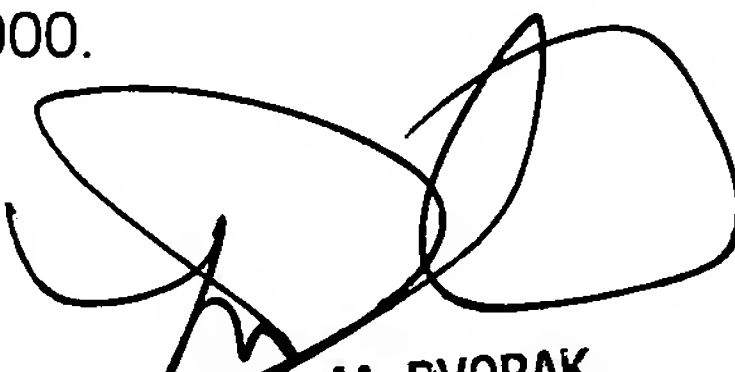
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK



7/25/06



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